

REMARKS

Favorable reconsideration of this application in light of the following discussion, is respectfully requested. Claims 1, 2, 4-7 and 9-12 are pending in the present application.

Rejections under 35 U.S.C. §103

In the outstanding Action, Claims 1, 2, 4-7 and 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 7,162,020 to Forte et al. ("Forte) in view of WO/1998/036551 to Taylor et al. ("Taylor").

Addressing now the rejection of Claims 1, 2, 4-7 and 9-12 under 35 U.S.C. § 103(a) as unpatentable over Forte in view of Taylor, this rejection is respectfully traversed. Claims 1, 4-6 and 9-12 have been previously amended to overcome the rejection under 35 U.S.C. § 103(a).

Forte describes a system and method for selectively establishing communication with one of plural devices associated with a single telephone number. However, as acknowledged by the outstanding action on page 3, Forte fails to describe or suggest a notification unit configured to transmit to said public telephone network through said public telephone communication unit, **"an outgoing call only setting signal which notifies said public telephone network than an incoming call cannot be responded,** only outgoing calling being viable in a case where the communication line connect to said private branch exchange is in use" as is recited in Claim 1. However, the outstanding Action cites Taylor as curing these deficiencies of Forte.

Taylor describes¹ an ISP 120 that enables a user of handset 140 to call the user of client computer 102 by dialing the telephone number for the extension 104 and converse with the user of client computer 102 to **receive incoming** calls from a remote telephone handset 104. Taylor further describes a PBX that only teaches that the ISP 120 may incorporate a number of additional

additional value added features such as voicemail, caller identification (via ANI) and the ability to recognize and display the originator of the incoming call (e.g., from within a PBX system) as well as the call type (i.e., voice, fax, video, etc.) with the ability to route the call to an alternate location that is best-suited to handle the incoming call.

Furthermore, Taylor generally describes² a PBX that provides telephony services 510 including particular services for handling computer telephony 506, and automatic call distribution (ACD) necessary for Private Branch Exchange (PBX) based systems. In contrast, Applicant's claimed invention recites an **outgoing** signal which informs the caller that an outgoing call is possible but that incoming calls may not be received on the line. Therefore, Alone or in combination with Forte, Taylor does not teach or suggest the claimed element "**an outgoing call only setting signal which notifies said public telephone network.**"

Figures 1 and 3 of Forte disclose WC 30 or 230 is connected **directly** to the extension telephones of the private branch exchange Hotel PBX 14. Therefore, in contrast to Applicants' claimed invention, the WCs 30 or 230 in Forte are not installed between PBX 14 and PSTN (on the communication line 20) as the claimed gateway devices 2a and 2b of the claimed invention. The claimed invention accomplishes the merits of an IP telephone without modifying both the present PBX and the present system of PSTN. Forte, on the other hand must utilize a cross-connect panel inside the PBX on the extension telephone side, such that the WC may detect an incoming telephone call to one of the external telephones.

Furthermore, according to Forte, the WC ignores the PBX when carrying out the extension switching processing. Therefore, significant system modification would need to be

¹ See Taylor at page 17, second paragraph and Figure one of Taylor.

² See Taylor at page 21, third paragraph.

applied to Forte in order for the PBX to have the functionality to acquire the results of switching processing from WC, as well as the functionality to refuse the arrival from the PSTN to a busy line, as is provided in the claimed invention.

The outstanding action recites that one of skill would have combined Forte with Taylor “to allow for a more efficient method for setting signal to notify public telephone network.” The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification. While the Taylor patent may teach that an ISP may incorporate a number of value added features such as voice mail, caller identification (via ANI) and the ability to recognize and display the originator of the incoming call, the Taylor reference fails to suggest why a person of ordinary skill in the art would be motivated to combine the Taylor system for displaying the originator of incoming calls from within a PBX system and the ability to route the call to alternate location that is best suited to handle the incoming call with Forte which must utilize a cross-connect panel inside the PBX on the extension telephone side, such that the WC may detect an incoming telephone call to one of the external telephones.

Similarly, the Forte patent states that the WC ignores the PBX when carrying out the extension switching processing. The Forte patent does not suggest that further improvement is desired, nor that another feature should be added to further improve the extension switching processing. In particular, the Forte patent does not suggest adding the list of value added features for connecting an incoming call to a computer system that is already engaged in a communication session, such as those disclosed in the Taylor reference. The Forte patent and Taylor reference, therefore, do not provide the motivation to perform the proposed modification of the Forte system and method. In other words, an attempt to bring in the isolated teaching of Taylor into the Forte system and method would amount to improperly picking and choosing features from different

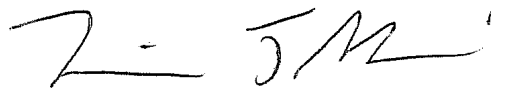
different references without regard to the teachings of the references as a whole.³ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record. In this case, there is nothing in the record supporting the Office Action's proposed modification of the Forte patent.

Consequently, the Examiner's rejection against claims 1, 6 and 11 under 35 U.S.C. §103 is respectfully requested to be withdrawn.

And in light of the above discussion and in view of the present amendment, the other claims 2-5, 6, 7, 9-12 dependent on base claims 1, 6 and 11 are also believed to be in condition for allowance.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds of rejection are believed to have been overcome. The application, as amended, is believed to be in condition of allowance. An early and favorable action to that effect is respectfully requested.

Respectfully Submitted,
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³ See In re Ehrreich 590 F2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")